

REMARKS

1. Status of the Claims

Claims 21, 24, 26, 30 and 34, as herein amended, claims 25, 29, 33, 35 and 36, as previously presented, and claims 22, 23, 27-29, 31 and 32 as filed are pending in the application. The asserted grounds of rejection are overcome by amendment in part and traversed by argument in part.

2. The amended claims fulfill the requirements of 35 U.S.C. §112.

Claims 21-36 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

Claim 21 is rejected on the grounds that there is no method step connecting the claimed method with the preamble. Applicants have amended this claim to overcome the asserted deficiency, and respectfully contend that their amendment overcomes this ground of rejection. Applicants thus respectfully request that the Examiner withdraw this ground of rejection.

Claim 24 is rejected on the grounds that there is no method step connecting the claimed method with the preamble. Applicants have amended this claim to overcome the asserted deficiency, and respectfully contend that their amendment overcomes this ground of rejection. Applicants thus respectfully request that the Examiner withdraw this ground of rejection.

Claim 24 is rejected on the grounds that there is no antecedent basis for the term “the placenta.” Applicants have amended this claim to overcome the asserted deficiency, and respectfully contend that their amendment overcomes this ground of rejection. Applicants thus respectfully request that the Examiner withdraw this ground of rejection.

Claim 24 is rejected on the grounds that there is no antecedent basis for the term “the human.” Applicants have amended this claim to overcome the asserted deficiency, and respectfully contend that their amendment overcomes this ground of rejection. Applicants thus respectfully request that the Examiner withdraw this ground of rejection.

Claim 26 is rejected on the grounds that it is not properly dependent on claim 24. Applicants have amended claim 26 to be dependent on claim 21, and respectfully contend that their amendment overcomes this ground of rejection. Applicants thus respectfully request that

the Examiner withdraw this ground of rejection.

Claims 22, 27, 31 and 35 are rejected on the grounds that “amplifiable RNA reporters” are not an amplification reaction. Applicants note that these species were explicitly disclosed throughout their specification. Also, the skilled worker would recognize that these species partake in linear amplification reactions used routinely to quantify nucleic acid amounts; see, for example, Lau et al., “Linear amplification of catalyzed reporter deposition technology on nylon membrane microarray,” Centre National de la Recherche Scientifique, at <http://cat.inist.fr/?aModele=afficheN&cpsidt=13904712>). Applicants thus respectfully contend that the skilled worker would understand the uses of these species in their claimed invention, and request that this ground of rejection be withdrawn.

Claims 23, 28, 32 and 36 are rejected on the grounds that ELISA reactions cannot be used for detection of nucleic acid products. Applicants point out that the skilled worker would recognize that the limitation is properly understood to be read “ELISA detection using biotinylated or modified primers.” Thus, in non-limiting example, an antibody specific for a reporter (such as biotin or other molecule) can be used to detect the specific presence of a particular nucleic acid species. Applicants thus respectfully contend that the skilled worker would understand the uses of these species in their claimed invention, and request that this ground of rejection be withdrawn.

Claim 34 is rejected on the grounds that there is no method step connecting the claimed method with the preamble. Applicants have amended this claim to overcome the asserted deficiency, and respectfully contend that their amendment overcomes this ground of rejection. Applicants thus respectfully request that the Examiner withdraw this ground of rejection.

Claims 21-36 stand rejected under 35 U.S.C. §112, first paragraph for lack of enablement. The Action asserts that the claimed methods are not enabled for detecting 5T4 RNA in plasma or serum of a pregnant woman, post-partum woman or woman with an antecedent pregnancy. Applicants respectfully contend that their specification fulfills the enablement requirement of 35 U.S.C. §112, first paragraph throughout the scope of the pending claims, and request that the Examiner withdraw this ground of rejection.

3. **Applicants acknowledge rejection on obvious-type double patenting grounds.**

Claims 21-36 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 24-36 and 39-41 co-owned and copending U.S. Serial No. 10/363,023.

Applicants acknowledge this rejection and will address this ground of rejection by filing a Terminal Disclaimer when the Examiner indicates that the claims are otherwise in condition for allowance.

CONCLUSION

Applicant believes that all requirements of patentability have been fully met, and allowance of the claims is respectfully solicited.

If the Examiner in charge of this application believes it to be helpful, he is invited to contact the undersigned attorney by telephone at (312) 913-0001.

Respectfully submitted,
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